

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/815, 108

**Applicant(s)**

TULI ET AL.

**Examiner**

JUNE HWU

**Art Unit**

1661

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-3-10-12-19-21-23 and 25-32

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/Anne R. Kubelik/  
Primary Examiner, Art Unit 1638

Continuation of 11, does NOT place the application in condition for allowance because:

103(a) over Mishra et al in view of Dasgupta et al:

Applicants argue that Mishra et al in view of Dasgupta et al do not support the use of an inositol free medium for 8-12 days before the globular stage resulting in synchronized growth. This is not found persuasive because Mishra et al taught a method of regenerating cotton through embryogenesis and Dasgupta et al was combined to show that it is not necessary to add inositol in the culture medium and it would have been obvious to adjust the deprivation of inositol for best results. With regard to the synchronized development of the embryos, is irrelevant because the end result is a plantlet and that is what Mishra et al and Dasgupta et al both taught.

Applicants argue that Mishra et al do not teach withholding of myo-inositol in embryogenesis media for starvation and then releasing myo-inositol for synchronized growth of embryos. This is not found persuasive because as stated above Mishra et al was combined with Dasgupta et al, wherein Mishra et al taught the regeneration of cotton embryos and Dasgupta et al taught the omission of inositol and then use of myo-inositol for regeneration. One cannot show nonobviousness by attacking the references individually where the rejections are based on combinations of references.

Applicants argue that Mishra et al report the development of embryos that were asynchronous but provides no solution to make them synchronous. This is not found persuasive because the claims do not cite the limitation that the embryos are synchronized developmentally.

Applicants argue that Dasgupta et al relate to genetic engineering method for stress tolerant plants and uses different media. This is not found persuasive because Dasgupta et al was combined with Mishra et al to show that calli could be cultured without myo-inositol and then myo-inositol is added for regeneration (see Table 3).

Applicants argue that Dasgupta et al used myo-inositol for regenerating plants from embryos and not for synchronized growth after starvation. This is not found persuasive because as stated above Dasgupta et al was combined with Mishra et al to show that inositol could be withheld and then added back to the medium for further development.

Applicants argue that Dasgupta et al do not teach the starvation of embryogenic tissues for inositol before globular stage for 8-12 days and then adding inositol for synchronized growth and further development. This is not found persuasive because the claims do not have the limitation that the starvation of embryogenic tissues are before the globular stage.

Applicants argue that the explant used by Dasgupta et al is immature embryos or immature seeds and not hypocotyl, mesocotyl or cotyledon pieces as cited in claim 1 and that the calli were left to grow for 2-3 months and then transferred to regeneration medium with myo-inositol. This is not found persuasive because Mishra et al taught the use of hypocotyl explant and Mishra et al was combined with Dasgupta et al to show inositol deprivation and that it would have been obvious to adjust the length of inositol deprivation to produce plantlet.

Applicants argue that Dasgupta et al used inositol only in the regeneration media unlike the present invention, wherein inositol is used in all media except for 8-12 days in embryogenic induction medium. This is not found persuasive because as stated above Dasgupta et al was combined with Mishra et al and it would have been obvious to try to deprive the callus tissue of inositol for 8-12 days or any length of time to achieve the claimed results.

Applicants argue that the Dasgupta et al media used for calli development into plants had inositol. This is not found persuasive because Mishra et al taught the all of their media contained inositol and Mishra et al was combined with Dasgupta et al to show that the media could be deprived of inositol.

Applicants argue that Dasgupta et al are silent that no inositol is necessary until the calli reached 10 mm in size. This is not found persuasive because paragraph [0125] stated that when the calli attained 10 mm then these calli were transferred to a regeneration medium containing inositol.

Applicants argue that the instant claims do cite increased embryogenesis when deprived of inositol and support can be found in the specification, Example 6 and Table 1. This is not found persuasive because there is no limitation in the instant claims for increased embryogenesis.

Applicants argue that the combination of Mishra et al and Dasgupta et al do not teach regeneration of cotton plants by short term inositol deprivation to attain synchronous embryos. This is not found persuasive because as stated above Mishra et al taught a method of regeneration of cotton and was combined with Dasgupta et al who taught that inositol is not necessary and that it would have been obvious to adjust the length of time for inositol deprivation to achieve plantlet.

There were no arguments present in the amendment filed on March 5, 2008 with regard to the rejection under 103(a) over Mishra et al in view of Dasgupta et al and further in view of Gupta et al.